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| 09/664,794      | 09/19/2000  | Franklin C. Bradshaw | PM 271077           | 1859             |

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EXAMINER

SELLS, JAMES D

| ART UNIT | PAPER NUMBER |
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1734

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 25

Application Number: 09/664,794  
Filing Date: September 19, 2000  
Appellant(s): BRADSHAW ET AL.

Mr. Bryan P. Collins (43,560)  
For Appellant

**EXAMINER'S ANSWER**

The Examiner's Answer mailed June 4, 2003 is vacated to fully appreciate the precedential opinion concerning a reissue recapture rejection set forth in *Ex Parte Eggert*. Note that appellant is permitted to file a reply brief in accordance with 37 CFR 1.193(b) to respond to this newly issued Examiner's Answer.

This is in response to the appeal brief filed February 14, 2003 and the reply brief filed July 24, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 36-48 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

As stated in the last office action, Claims 36-46 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In US Patent Application 08/247,003 (US Patent 5,584,962), applicant surrendered subject matter during prosecution of the application in order to overcome a rejection. This surrendered subject matter includes:

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a pretensioning means including a tensioning cap affixed to the cores the caps having an end plate engaging the end of the associated core and the plate with securement means engagable in the mounting means and further including biasing means for applying a predetermined force biasing the end plate into engagement with the end of the roll core.

Newly added claim 36 does not include the limitations which applicant presented in application 08/247,003 to overcome the prior art of record. Thus applicant is attempting to recapture subject matter that was surrendered in application 08/247,003. See MPEP 1412.02 – examples A-C.

**(11) Response to Argument**

Applicant's arguments filed February 14, 2003 in the Appeal Brief have been fully considered but they are not persuasive.

Applicant argues that the recapture rule does not apply when the reissue claims are narrower than the claim originally sought. Applicant acknowledges that the above limitations were added to claim 10 of the '962 patent for purposed of securing its allowance. However, applicant asserts that the limitations in claims 36 and 47 concerning the "outer shell portion" materially narrow the reissue claims in that they define the specific parts of the frame that move relative to one another. Thus, applicant concludes that claims 36 and 47 are materially different than patent claim 10 and allowing applicant to broaden out the claim limitations concerning the 'pre-tensioning means" would not constitute impermissible recapture because the applicant is not regaining the same claim scope sought during prosecution of the patent.

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The examiner does not agree with applicant's conclusion. The narrowing aspect of the claims (i.e. the newly added "outer shell portion") is not related to the broadening aspect (i.e. the "pre-tensioning means"). Therefore, the reissue claims have not been narrowed in any material respect compared with their broadening. Thus the newly added narrowing limitation does not modify the claims such that the scope of the claims no longer result in a recapture of the surrendered subject matter. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution, this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634(Fed. Cir. 1998); see also *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up.") Also see *Pannu v. Storz Instruments Inc.*, 59 USPQ2d 1597 (CAFC 2001).

Applicant argues that case law does not support the Examiner's position. In particular, applicant argues that the proper focus is on the scope of the claims, not on the individual feature or element purportedly given up during prosecution of the original application. Applicant further asserts that the examiner has simply identified the limitations from claim 10 that are no longer present in the pending independent reissue claims, and has not focused on the other, materially narrowing changes made to the claim scope. The examiner does not agree. The examiner has considered the materially narrowing changes relating to the "outer shell portion." However, these

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narrowing limitations do not affect and are not related to the limitations concerning the "pre-tensioning means". Thus the newly added limitations relating to the "outer shell portion" do not affect the scope of the limitations concerning the "pre-tensioning means" and the applicant's argument is believed to be incorrect in this instance.

Applicant argues that method claim 47 is of a different scope than that of claim 36. In particular, claim 47 recites a specific set of acts for using the apparatus. However, these narrowing limitations also do not affect and are not related to the limitations concerning the "pre-tensioning means". Thus the newly added limitations relating to the set of acts for using the apparatus do not affect the scope of the limitations concerning the "pre-tensioning means" and the applicant's argument is believed to be incorrect in this instance.

Applicant argues no method claim was ever presented during the prosecution of the '962 patent. Therefore the Applicants on reissue cannot be recapturing surrendered claim scope by inclusion of method claim 47 because no method was ever presented during the prosecution of the '962 patent. The examiner does not agree. Method claim 47 includes the same limitations concerning the "frame" and its "outer shell" as apparatus claim 36. Method claim 47 also omits the limitations concerning the "pre-tension means" in the same manner as claim 36. In addition the examiner believes claims 36 and 47 are of such similar scope that he has not made a restriction requirement in the application. Therefore the examiner believes method claim 47 is subject to the same improper recapture rejection as claim 36.

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Applicant argues the reissue claims are materially narrower by virtue of the limitations concerning the "outer shell" than any "surrendered" claim originally presented and rejected during prosecution, and thus would best fit the examples of valid reissue claims as enumerated by the Board in *Ex Parte Eggert*. The examiner does not agree.

As stated above in the rejection, the surrendered subject matter includes:

a pretensioning means including a tensioning cap affixed to the cores the caps having an end plate engaging the end of the associated core and the plate with securement means engagable in the mounting means and further including biasing means for applying a predetermined force biasing the end plate into engagement with the end of the roll core.

Applicant has added new limitations to the claims by reciting that the "frame" includes:

an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower shell portion by manually engaging said upper shell portion directly and lifting said upper shell portion upwardly to said open position thereof.

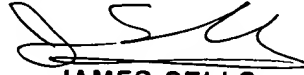
These added limitations concerning the "outer shell" are not related to the surrendered subject concerning the "pretension means". As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. Therefore the recapture rejection is believed to be appropriate in this instance.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**JAMES SELLS**  
**PRIMARY EXAMINER**  
**TECH. CENTER 1700**

November 4, 2003

Conferees

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